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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,736	01/10/2005	Kazuhiko Takabayashi	09812.0202	9751
22852	7590	04/25/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER SCHWARTZ, DARREN B	
			ART UNIT	PAPER NUMBER
			4193	
			MAIL DATE	DELIVERY MODE
			04/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/520,736

Applicant(s)

TAKABAYASHI ET AL.

Examiner

DARREN B. SCHWARTZ

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-26 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 10 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 1-10-05 4-13-06
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: Claim 4 recites "provision" (see claim 4 on page 29, line 5). This limitation is nowhere recited in the specification. Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 26 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 26 is directed to a program, *per se*. The body of the claim is directed to the logic steps of the program itself, although, the claim recites memory, no actual structure of the memory is being recited. Furthermore, no actual implementation of the machine/computer is recited into the claim and no actual execution of the program has been implemented. The claim is basically reciting what program steps a program can do. Therefore, it is treated as a program alone.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 6, 9-12, 14, 17-19, 22 and 26 rejected under 35 U.S.C. 102(e) as being anticipated by Ayres et al (U.S. Pat Pub 2003/0078986 A1), hereinafter referred to as Ayres.

Re claims 1, 9, 17 and 26: Ayres teaches a device-to-device authentication system for authenticating whether or not devices on a network are connected within a certain range (§30, lines 1-2; §75), characterized in that: each of said devices (Fig 1, elts 12, 14, 16; Multimedia Distribution Kiosks/MDKs; Fig 2, elt 110) interconnected via said network (§22, lines 1-4; §83) has a mediating device interface (§5: for example, a Bluetooth; Fig 2, elt 112) for physically accessing a mediating device (Fig 1, elts 52, 54, 56, 58; see also §2: for example, a PDA and §25, lines 1-3; col 2 of §103, lines 1-4) such that said mediating device removable (Fig 1, elts 52, 54, 56, 58; §12), and local environment management means for authenticating that another device (Fig 1, elts 12, 14, 16) physically accessing said same mediating device (Fig 1, elts 52, 54, 56, 58; see also §2: for example, a PDA) within a predetermined period of time (§20, lines 15-16; §95, lines 14-16) is located in a local environment where contents are available (§30, lines 1; particularly elt 114; §75); wherein use of said contents is allowed between said devices in said local environment (§31; §34; §45; §50; §63; §77).

Re claims 2, 10 and 19: Ayres teaches one of said devices is a home server for legitimately acquiring said contents (§33, lines 1-2; Ayres treats the MDKs as "client/server" devices; Fig 2, elt 140), whereas the other device is a client for making a request for said contents to said home server for use (§37; §50); wherein, in response to confirmation of presence of both said devices on said same home network by said

local environment management means (Fig 2, elts 100, 110, 130 & 140), said home server provides said contents and/or issues a license for said contents to said client (¶37; ¶92: teaches billing by various means).

Re claims 3 and 11: Ayres teaches two or more home servers are able to be installed on said home network (Fig 1, elts 28 & 30); wherein each said home server provides said contents and/or issues a license for said contents to said client that is confirmed to be present on said same home network (¶28, ¶37, ¶45).

Re claims 4 and 12: Ayres teaches said client is able to be received provision of said contents and/or issuance of said license from two or more said home servers on said same home network (Fig 1, elts 28 & 30; ¶28, ¶37, ¶45).

Re claims 6, 14 and 22: Ayres teaches said mediating device is capable of retaining predetermined identification information (¶30, lines 14-16: device ID); and said local environment management means authenticates that each of said devices is in said local environment based on a fact that each of said devices physically accessing said mediating device reads the same identification information from said mediating device (¶30, lines 14-16; ¶45) and/or that time at which each of said devices reads the identification information is within a predetermined period of time (¶20, lines 15-16; ¶95, lines 14-16).

Re claim 19: Ayres teaches said communication apparatus operates as a client for making a request for said contents to a home server for use on said network(¶37; ¶50); said content-using means receives provision of said contents and/or issuance of a license for said contents only from a home server confirmed to be present on said same

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local environment by said local environment management means (Fig 1, elts 28 & 30; ¶28, ¶37, ¶45).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5, 7, 8, 13, 15, 16, 20, 21, 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ayres et al (U.S. Pat Pub 2003/0078986 A1), hereinafter referred to as Ayres, in view of Morita et al (U.S. Pat Pub 2002/0073070 A1), hereinafter referred to as Morita.

Re claims 5, 13 and 21: Ayres teaches said client is able to use said contents acquired from a plurality of home servers on said same home network (¶25-¶28 and ¶94),

However, Ayres is silent when upon connection to a home server on an other home network, said client is not able to use said contents acquired from said home servers on said home networks other than said other home network

Morita teaches upon connection to a home server on an other home network, said client is not able to use said contents acquired from said home servers on said home networks other than said other home network (Fig 5 and Fig 6; ¶117; ¶122; see also fig 10, elts S11, S13 & S15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Ayres reference to disallow usage of content moved out of contact with the original network and placed in range of a different network, as taught by Morita, for the purpose of providing digital content protection and prevent the illegal copying and/or distribution of content.

Re claims 7 and 15: Ayres teaches said mediating device has a memory for retaining confidential information in a secure manner (§12: note that one skilled in the art would concur that PDAs can store confidential info in a secure manner); one of said devices physically accessing said mediating device is capable of generating said confidential information (Fig 2, elt 194: ¶156); within a predetermined period of time (§120, lines 15-16; ¶95, lines 14-16)

However, Ayres is silent with regard to said local environment management means authenticates that each of said devices is located in said local environment based on a fact that said confidential information generated from said one of said devices is able to be acquired by another device via said mediating device.

Morita teaches said local environment management means authenticates that each of said devices is located in said local environment based on a fact that said confidential information generated from said one of said devices is able to be acquired by another device via said mediating device (Morita: Fig 4, ¶106-108) within a predetermined period of time (Ayres: ¶120, lines 15-16; ¶95, lines 14-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Ayres reference to have the portable device

store confidential information generated from one of said "hub" devices, as taught by Morita, for the purpose of preventing the illegal transmittal and/or copying of content from one "device"/"portable device" to another "device"/"portable device."

Re claims 8 and 16: The combination of Ayres and Morita teaches said device generated said confidential information erases said confidential information after elapse of a predetermined period of time (Morita: ¶28; ¶33; ¶34); and said local environment management means authenticates that a device, which is capable of sharing said confidential information prior to loss of said confidential information in said device generated said confidential information, is located in said local environment (Morita: ¶28; ¶33; ¶34). Morita teaches that once content is moved, it is immediately deleted off the device.

Re claim 20: Ayres teaches two or more home servers are able to be installed under said local environment (Fig 1, elts 28 & 30); said content-using means receives provision of said contents and/or issuance of a license for said contents from said two or more home servers confirmed to be present on said same local environment by said local environment management means (Fig 1, elts 28 & 30; ¶28, ¶37, ¶45). characterized in that: said content-using means is able to use said contents acquired from a plurality of home servers under said same local environment (¶31; ¶34; ¶45; ¶50; ¶63; ¶77).

However, Ayres is silent to connection to a home server on an other home network, said client is not able to use said contents acquired from said home servers under said local environment other than said other home network.

Morita teaches the connection to a home server on an other home network, said client is not able to use said contents acquired from said home servers under said local environment other than said other home network (Fig 5 and Fig 6; ¶117; ¶122; see also fig 10, elts S11, S13 & S15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Ayres reference to disallow usage of content moved out of contact with the original network and placed in range of a different network, as taught by Morita, for the purpose of providing digital content protection and prevent the illegal copying and/or distribution of content.

Re claim 23: Ayres teaches said mediating device has a memory for retaining confidential information in a secure manner (¶2: note that one skilled in the art would concur that PDAs can store confidential info in a secure manner); said communication apparatus further has a confidential information generation apparatus for generating said confidential information (Fig 2, elt 194: ¶56); said mediating device interface writes said confidential information to said memory of said mediating device in response to physical access from said mediating device (¶30);

However, Ayres is silent as to said local environment management means authenticates that another devices is located in said local environment of said local environment management means based on a fact that said confidential information generated from said local environment management means is able to be acquired by said another device via said mediating device within a predetermined period of time.

Morita teaches said local environment management means authenticates that another devices is located in said local environment of said local environment management means based on a fact that said confidential information generated from said local environment management means is able to be acquired by said another device via said mediating device (Morita: Fig 4, ¶106-108) within a predetermined period of time (Ayres: ¶20, lines 15-16; ¶95, lines 14-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Ayres reference to have the portable device store confidential information generated from one of said "hub" devices, as taught by Morita, for the purpose of preventing the illegal transmittal and/or copying of content from one "device"/"portable device" to another "device"/"portable device."

Re claim 24: The combination of Ayres and Morita teaches said mediating device has a memory for retaining confidential information in a secure manner (Ayres: ¶2, note that one skilled in the art would concur that PDAs can store confidential info in a secure manner; Morita: ¶31); said mediating device interface takes out said confidential information from said memory of said mediating device in response to physical access from said mediating device (Morita: ¶33-¶34); and said local environment management means authenticates that a device, which reads same confidential information from said mediating device and/or reads said confidential information within a predetermined period of time (Ayres: ¶20, lines 15-16; ¶95, lines 14-16; Morita: ¶28; ¶33; ¶34), is located in said local environment of said local environment management means (Morita: ¶28; ¶33; ¶34).

Re claim 25: The combination of Ayres and Morita teaches said confidential information is lost after elapse of a predetermined period of time from generation (Morita: ¶28; ¶33; ¶34); and said local environment management means authenticates that a device, which is capable of sharing said confidential information prior to loss of said confidential information, is located in said local environment (Morita: ¶28; ¶33; ¶34). Morita teaches that once content is moved, it is immediately deleted off the device.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat Pub 2001/0037452 A1

U.S. Pat 6697944 B1

U.S. Pat 7096504 B1

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren B. Schwartz whose telephone number is 571-270-3850. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Taghi Arani can be reached on 571-272-3787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DS

/Taghi T. Arani/
Supervisory Patent Examiner, Art Unit 4193
4/24/2008